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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/801,177	03/15/2004	Richard S. Belliveau		1469

27550 7590 04/26/2006

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EXAMINER

LEE, Y MY QUACH

ART UNIT	PAPER NUMBER
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2875

DATE MAILED: 04/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/801,177	Applicant(s) BELLIVEAU, RICHARD S.	
	Examiner Lee Y Quach	Art Unit 2875	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 02 March 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____.
 Claim(s) objected to: _____.
 Claim(s) rejected: _____.
 Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____
 12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
 13. ☒ Other: See Continuation Sheet.

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Continuation of 13. Other:

The remarks filed March 2, 2006 has been considered but they are not persuasive. The following is a summary of the prosecution history of the reissue application. In the office action of March 8, 2005, the office action stated that after foreclosing Applicant's right to claim any subject matter other than the invention of "a plurality of light sources mounted on a flexible substrate with a flexible device for flexing the flexible substrate by applying pressure to the substrate to cause the substrate to deform in a first state and to not deform in a second state to cause the light emitted from the light sources concentrated in different directions" by electing the patent claimed invention in the original patent and by failing to file a divisional application, Applicant cannot now undo the election by contending, on the present record, that his failure to include claims to the inventions of newly added claims 13 to 78 was due to an "error". Weiler, 790 F.2d at 1582, 229 USPQ at 677. The failure to present claims 13 to 78 in the instant reissue application cannot be considered an error that supports reissuance of the patent within the meaning of 35 USC 251 first paragraph, and the error attempted to be corrected here is simply not the type of error that is correctable through reissue.

Subsequent to this office action of March 8, 2005, Applicant's reply was filed on May 11, 2005. The reply stated that the present reissue claims 13 to 82 combine the elected species of Figures 3F with non elected species of figures 3D and 12C and therefore are in the nature of or analogous to a linking claim. Applicant stated that In Re Doyle, failure to present linking claims was an error in the issued patent correctable by reissue and that the linking claims In Re Doyle read both on a non elected group of species and an elected group of species. In light of In Re Doyle, Applicant relates that the reissue claims 13 to 82 are in the nature of a linking claim. Applicant therefore erred by failing to appreciate the scope of the invention at the time of the original patent grant and failing to present one or more claims which combine part of the elected species and part of the non elected species.


In response to Applicant' reply of May 11, 2005, a final office action was issued in November 4, 2005. The office action stated that a linking claim, according to In Re Doyle, is a claim broad enough to read on the invention elected (and patented) together with the invention not elected. Note MPEP 1412.01 Page 1400-17 August 2005. Because the reissue claims are not broad enough to read on, meaning generic to, the invention elected (and patented) together

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with the invention not elected, the reissue claims are therefore not analogous to the linking claims and the error as failing to present linking claims according to In Re Doyle providing base for reissue of the patent has not been met. Since the reissue claims are not corresponding to linking claims, meaning generic to the invention elected (and patented) together with the invention not elected, consequently, there is no error present or relied upon to support the reissue application, and the patent therefore will not be reissue.

Subsequent to the final office action of November 4, 2005, Applicant reply was filed on March 2, 2006 and stated that the reissue claims 13 to 82 are linking claims and that linking claims are not limited to claims broad enough to read on both the elected and non elected claims. As provided by MPEP 809, linking claims are "one or more claims ... inseparable from the elected and non elected claims and thus linking together the otherwise divisible inventions." Applicant also stated that the instant reissue claims satisfy this requirement even though they are not the "genus" type of linking claims at issue in In Re Doyle. Applicant further stated that reissue claims 13 to 82 appear to qualify as subcombination claims linking plural combinations, a separate type of linking claim expressly recognized by MPEP 809 and as recited in the reply. These remarks do not materially reduce or simplify the issues to a better form but rather they raise new issues that would require further consideration. In addition, it should be noted that the reissue statute was not enacted for correcting the original patent because of failing to present the types of linking claims as argued by Applicant or all patent prosecution problems. A linking claim that permitted to be filed in a reissue application is a claim that is broad enough to read on the invention elected (and patented) together with the invention not elected. MPEP 1402.01. Since the reissue claims 13 to 82 are not linking claims, meaning generic to the invention elected (and patented) together with the invention not elected, consequently, there is no error present or relied upon to support the reissue application, and the patent therefore will not be reissue. Accordingly, the final rejection is maintained.

Y. Q.
April 11, 2006



Y Quach Lee
Primary Examiner
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